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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,628	02/23/2004	Joseph P. Errico	F-272	8401
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SPINE MP				
LERNER, DAVID, et al.				
600 SOUTH AVENUE WEST				
WESTFIELD, NJ 07090				
EXAMINER				
CUMBERLEDGE, JERRY L				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
11/14/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,628

Applicant(s)

ERRICO ET AL.

Examiner

JERRY CUMBERLEDGE

Art Unit

3733

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date 07/25/2008
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

Applicant's arguments, pages 8 and 9 of the remarks filed 07/28/2008 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bicks (US Pat. 3,195,380).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3, 5-18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bicks (US Pat. 3,195,380).

Bicks discloses an apparatus for manipulating an orthopedic device, the apparatus comprising: at least one shaft (Fig. 2, ref. 12) having a longitudinal axis (Fig. 2) and a shaft distal end (Fig. 2, near ref. 13) adapted for engagement with an orthopedic device (Fig. 4), the shaft distal end further having forward surfaces for engagement (Fig. 2, angled and flat surfaces of ref. 13) with corresponding confronting surfaces of an orthopedic implant (Fig. 3). The forward surfaces of the shaft distal end are flat and angled with respect to one another (Fig. 2). The apparatus further comprising at least one vertebral body stop (Fig. 3, ref. 15), wherein the stop prevents

over-insertion of the device into an intervertebral space.

Bicks discloses an apparatus for holding an orthopedic device, the apparatus comprising: a shaft (Fig. 2, ref. 12) having a distal end (Fig. 2, near ref. 12) and a longitudinal axis (Fig. 2); an extendible and retractable holding pin (Fig. 2, ref. 14) located internal to at least a portion of the shaft distal end (Fig. 2); and a spring coupled to the holding pin (Fig. 3, ref. 20) and located internal to at least a portion of the shaft (Fig. 2) and biasing the pin toward retraction along a direction parallel to the longitudinal axis of the shaft (Fig. 2); wherein a holding pin distal end (Fig. 4, end of ref. 14, near ref. 16) of the holding pin is bent downwardly such that the holding pin distal end prevents the holding pin from being entirely retracted within the shaft under the bias (Fig. 4); wherein the spring spring-loads the holding pin toward at least one shaft distal end surface of the shaft distal end (Fig. 4). The holding pin extends through the shaft distal end in a direction along a longitudinal axis of the shaft (Fig. 4). The apparatus further comprising a flange (Fig. 3, ref. 21) mechanically coupled to the holding pin, wherein exerting pressure on the flange in a distal direction overcomes the bias of the spring to space the holding pin at a distance from the shaft distal end. The apparatus further comprising a knob (Fig. 3, ref. 10) coupled to the shaft, wherein rotation of the knob moves the flange such that the holding pin moves closer to the shaft distal end, and wherein reverse rotation of the knob moves the flange such that the holding pin moves away from the shaft distal end (Figs. 2-4). The knob is threaded to the shaft (Fig. 4, below ref. 21). Interference between threads of the knob and threads of the shaft lock the holding pin in position (Fig. 4).

With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over the device of Bicks, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bicks (US Pat. 3,195,380).

Bicks discloses the claimed invention except for the forward surfaces being angled with respect to one another at an orientation angle of approximately 33.4 degrees. It would have been obvious to one having ordinary skill in the art at the time

the invention was made to have angled the forward surfaces of Bicks at an angle of approximately 33.4 degrees to one another, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please see attached PTO-892.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JERRY CUMBERLEDGE whose telephone number is (571)272-2289. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. C./
Examiner, Art Unit 3733
/Eduardo C. Robert/
Supervisory Patent Examiner, Art Unit 3733